

REMARKS

The present amendment is submitted in response to the Office Action dated November 26, 2004, which set a three-month period for response, making this amendment due by February 26, 2005.

Claims 1 and 5 are pending in this application.

In the Office Action, claim 3 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 1 was rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,527,060 to Schoeps. Claims 2-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schoeps in view of U.S. Patent No. 6,796,389 to Pusateri et al or U.S. Patent No. 4,643,263 to Karden.

In the present amendment, claim 1 has been amended to more clearly define the present invention over the cited references by adding the features of claims 2-4, which have been canceled. Claim 5 has been amended to depend from claim 1, rather than claim 4.

The Applicant respectfully submits that claim 1 defines a patentably distinct combination of elements neither shown nor suggested by the cited references.

The primary reference to Schoeps fails to disclose that the guides, in which the handle can be supported longitudinally displaceably on the hand held power tool, are groove-shaped and tongue-shaped. In addition, the device of

Schoeps operates as a pneumatic tool, in which the problem of current transfer between the handle and the hand held power tool is not relevant.

The Applicant furthermore respectfully submit that Schoeps is not a proper reference under 35 USC 102 pursuant to the guidelines set forth in the last paragraph of **MPEP section 2131**, where it is stated that "a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference", and that "the identical invention must be shown in as complete detail as is contained in the ... claim". Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

Likewise, the cited combination of references does not render obvious the present invention. The Pusateri reference provides no teaching in the direction of the features discussed above. With Pusateri, the handle 26 is not displaceably arranged on the hand held tool 21. Rather, only a covering made from flexible material is positioned on the handle 26 for improved gripping ability. Again, Pusateri provides no groove- and tongue-shaped guides that make possible this longitudinal displaceability of the handle.

Likewise, the reference to Karden fails to disclose or suggest the longitudinal displaceability of a handle on a hand held power tool. With Karden, two handles are pivotable on the hand held power tool; however, they are not longitudinally displaceably supported. In this connection, then, Karden also cannot

provide any groove- and tongue-shaped grooves, which make possible a longitudinal displacement of the handle on the tool.

In conclusion, the secondary references to Pusateri and Karden fail to disclose or suggested a longitudinally displaceable handle. Thus, even if these documents are combined with Schoeps, the practitioner could not be lead to the present invention, since none of these references teach or suggest the above features of amended claim 1. It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in **MPEP section 2143.01**. When establishing obviousness under Section 103, it is not pertinent whether the prior art device possess the functional characteristics of the claimed invention, if the reference does not describe or suggest its structure. *In re Mills*, 16 USPQ 2d 1430, 1432-33 (Fed. Cir. 1990).


For the reasons set forth above, the Applicant respectfully submits that claims 1 and 5 are patentable over the cited art. The Applicant further requests withdrawal of the rejections under 35 U.S.C. 102 and 103 and reconsideration of the claims as herein amended.

In light of the foregoing amendments and arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss

appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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